

No. 2960.

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United States  
Circuit Court of Appeals,  
FOR THE NINTH CIRCUIT.

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Porterville Citrus Association,

*Appellant,*

*vs.*

Fred Stebler,

*Appellee.*

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APPELLEE'S BRIEF.

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APPELLEE'S BRIEF.

This case comes before this court on an appeal by the Porterville Citrus Association, defendant in the trial court, from a final decree of the District Court of the United States for the Southern District of California, Northern Division.

Appellee was complainant in the trial court and appellant the defendant, and for convenience the parties will be so referred to herein.

On November, 1915, complainant filed his Bill in Equity to enjoin the use by defendant of certain orange grading and distributing apparatus *then* being installed for defendant by George D. Parker of Riverside, California. Mr. Parker assumed the control and expense

of defending the suit and is the actual, although not the nominal, defendant.

At the time of filing the bill complainant moved for a preliminary injunction.

Defendant, through Mr. Parker's attorney, and at Mr. Parker's cost and expense, answered. When the motion for preliminary injunction came on for hearing His Honor, Judge Oscar A. Trippet, expressed a desire to personally inspect the infringing machines in operation. For this purpose His Honor in the last week of December, 1915, in the presence of counsel for both parties, at Porterville, Cal., inspected the machines involved and observed the operation thereof in actual use. At the same time His Honor also inspected the machines involved in the companion case, appeal 2961 in this court, wherein the same patents are involved.

Judge Trippet then offered to set these cases for trial at Los Angeles during the first week in January, 1916, stating that he could try the same on the merits as readily as on motion for temporary injunction. As these cases were Northern Division cases they could not be transferred to Los Angeles without the consent of the parties, and at that time defendants objected to such transfer. Trial at the May, 1916, term of court in Fresno was continued to suit the convenience of the judge and upon defendant's request. At that time the parties stipulated the transfer to Los Angeles for trial.

In July, 1916, the cases were tried in open court, all the evidence being educed in open court, except

certain depositions taken in Florida and in Hanford, Cal., by defendant, *and except the two actual inspections of the machines in actual use.* It is to be particularly noted that after hearing all the oral evidence the court again inspected similar machines which had been installed at a packing house near Tustin, Orange county, Cal., by Mr. Parker, and which were conceded to be substantially the same as the Porterville and Mid-California installations by Mr. Parker. As Mr. Parker was defending these suits the trial actually was converted into testing the infringement by Mr. Parker.

Both at the time of the Porterville inspection by the court and of the Orange county inspection of the defendant's machines in use, His Honor also inspected the Stebler machines in use.

It is therefore seen that *both before* starting the trial of these cases *and after* hearing all the oral evidence the court had before it, as a part of the proofs considered and to be considered by it, the actual machines as they were being actually used. Both those of complainant and defendant. The trial judge had an unusual opportunity to ascertain the truth or falsity of the various contentions of the parties. It will not be denied that upon both such occasions His Honor requested the respective attorneys to point out on the machines in operation the various parts and their adjustments and interrelations and state to him their respective contentions. Judge Trippet, therefore, had unusual opportunities for correctly ascertaining and judging the mechanics of the machines and testing the correctness and weight of the issues raised. He heard



the testimony of the witnesses, observed their demeanor on the stand, and *then* saw the actual machines in actual use. No greater opportunity could be afforded a trier of fact. Under these circumstances his conclusions must be entitled *to even greater weight than usual*.

As said by this court in *Central California Canneries Company v. Dunkley Company* (Case No. 2915, opinion filed October 1, 1917):

“The rule of law applicable to the evidence in this case was stated by the Supreme Court in *Adamson v. Gilland*, 242 U. S. 350, 353, where the court says: ‘Considering that a patent has been granted to the plaintiff the case is preeminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses “depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.” *Davis v. Schwartz*, 155 U. S. 631, 636.’ ”

No rule of law is better settled than that where a party appeals from a decision against him and seeks to review the findings of fact of a jury or court he must present to the appellate court *all* the evidence upon which such finding was based. The fact that after hearing all the oral evidence the trial judge visited the machines in controversy, and inspected them in actual use in view of the oral evidence and the issues raised, must place a burden upon the appellant to place before this court an equal opportunity for judging the facts, if he is to seek a review of such findings of fact. It is clear that His Honor, Judge Trippet, did

not adjudge the issues of this case *solely* upon the transcript of record filed in this court.

Defendant's assignments of error [Transcript, page 825] are ten in number and illustrate the lack of care with which defendant has proceeded, both in perfecting its appeal herein and in briefing the same. It will be noted that the sixth assignment of error is addressed to alleged error in the decree "in holding the defendant Porterville Citrus Association to be liable for and directing the complainant Fred Stebler to recover of and from it, the profits, gains and advantages," etc. Reference to the decree [Transcript, pages 28-31] shows clearly that no accounting was awarded and that the only relief decreed was the injunction and the incidental judgment for costs and disbursements. This carelessness on the part of defendant is also reiterated by its eighth assignment of error, referring to the Robert Strain reissue patent number 12,297 and the decree of infringement thereof. It is to be noted that this latter assignment of error does not challenge the decree that said reissued letters patent are valid. The defendant is in no position to assert this eighth assignment of error. While the record will make plain the fact that the only issue ever raised as to infringement of these reissued letters patent was in reference to the adjustable brackets in which the grading rollers of defendant's machines were mounted, it is to be particularly noted that defendant's contention, supported by the testimony of the witnesses called by the defendant, was that such adjustment was provided in such brackets *solely* for the

initial installation of the machines and was never either intended for or used as a means for adjusting the sizing-openings or grade-openings of the grader element or machine. For this reason, after the testimony had been closed and during the final argument, when this portion of the case was under discussion the following stipulation was made by defendants (the quotation is from the transcript of the arguments before the trial court and is the portion read to Your Honors by appellee's counsel at the argument of this appeal):

"The Court: Well, now all the evidence here is that they did not intend to adjust it. They usually testified they never have adjusted and never expect to.

Mr. Lyon: Then the answer to that is, insofar as an injunction against them doing it, it will not injure them. The court can readily see they are capable of being so used—

The Court: So far as the injunction against their changing that, using it for the adjustment, the defense has consented that the injunction be issued.

Mr. Acker: I consented to that at Porterville.

Mr. Lyon: That is all there is as to that in this case.

The Court: But I thought you were contending that they had to remove that possibility.

Mr. Lyon: Well, I don't care whether they remove it or not."

The decree does not require the removal of the adjusting means from the roller-supporting brackets. It grants no accounting of profits or damages on ac-



count of such infringement. It simply follows the stipulation of defendant and enjoins that use of such adjustment, which defendant contended was never either used or intended for use. It is:

“and from at any time whatsoever in any manner making use of those certain adjustable means whereby the roller sections may be adjusted toward or away from the grading belt; and from maintaining in any of said machines the slotted brackets by means of which the roller sections are supported unless the slots of such brackets are permanently sealed by some substance such as babbit metal permanently fixing said brackets and rollers against adjustment.” [Transcript Record, page 31.]

This was the stipulation of defendant. A copy of the decree as proposed was served upon defendant's counsel before it was presented to the court for signing, and notice of the time when it would be presented was given. This was admitted by defendant's counsel at the oral argument in this court.

It is submitted that defendant is bound by its stipulation. It is further submitted that if this decree was not in accord with the opinion of the lower court, or of its minute order, it would have been corrected upon its having been brought to the attention of the court or of complainant's counsel. Neither complainant nor defendant have any real interest in this question thus covered by this assignment of error. Whether this portion of the injunction is retained or abrogated is immaterial to complainant,—as it is to defendant. But it is submitted that in good faith it should be left to

the trial court to change, if it is to be now altered. It was clearly upon defendant's consent that it was granted.

In this connection complainant wishes to supplement what defendant's counsel has stated at the argument: That neither complainant nor defendant ever knew of or saw the minute order of August 1, 1916 [Transcript Record, page 27] until after the entry of the decree. Complainant never saw it or heard of it until it appeared in a printed copy of the transcript of record on appeal. Defendant's counsel was present at the taxation of costs in this case and did not then raise any question of the decree being in accord with defendant's stipulation and the opinion of the court. His Honor, Judge Trippet, decided the case orally, and from his oral remarks the decree was prepared.

As a change of the decree in this respect would not affect the substantial interests of either of the parties and the defendant is now seeking to be relieved of its stipulation upon which the court acted, it is submitted that in any event it would be unjust to adjudge any costs on this appeal on account of this matter. On the contrary, as defendant is at fault, it should not complain.

Defendant admits it never called this matter to the attention of the District Court or even requested any modification of the decree in this respect. The District Court and complainant acted upon defendant's repeated concession and stipulation. Was it *error* for the District Court to enjoin defendant from using this adjustment when defendant consented and stipulated it be so enjoined?

The substantial controversy in this case arises out of the Stebler patent number 943,799, granted December 21, 1909, to complainant for his invention. As we shall specifically point out hereinafter, defendant's conception of this invention and his counsel's interpretation both of the invention and of the Stebler patent are entirely erroneous and based upon an erroneous hypothesis.

In the first place defendant's assumption that Mr. Stebler's invention was limited to the use of "a short grader," or that his invention resided solely in the employment of a short grader and a distributing system in connection therewith, does violence not only to the spirit of the Stebler invention but also to the plain terms of the Stebler patent. Defendant is also in error in stating that the Robert Strain grader was only made in not to exceed fifteen feet lengths. Mr. Stebler, even prior to the invention of the subject matter of the patent in suit, has manufactured and installed these graders in lengths varying from twenty to thirty-two feet. All of these facts were before this court in the case of *Stebler v. Riverside Heights Orange Growers Association*, Appeal No. 2232 (205 Fed. 735).

The specification of the Stebler patent states a number of objects of the invention, and, after enumerating several of these says: "Further objects and ends to be attained will be apparent from the construction and operation of my distributing apparatus as hereinafter described and shown in the drawings," etc. [Transcript Record, page 519, lines 5-12, column 1.] This

statement shows conclusively that Mr. Stebler did not intend to limit himself solely to the objects or to the advantages which he had theretofore pointed out, but recognized that others inhered in any embodiment of his invention.

While it is true that Mr. Stebler says that *one* object or advantage of his invention was to enable the use of a short sizer or grader and still deliver the separated or sized fruits in bins of such width as to provide easy access thereto for the packers, yet this is stated to be only one object or "another object" of his invention. Mr. Stebler does not state that his invention is limited thereto. In introducing the subject of his invention he says:

"This invention relates to means for carrying or distributing fruit, and is more particularly designed for use in connection with a fruit sizer or grader, and has for *its general object* the provision of simple and efficient means whereby the several grades or sizes of fruits, such, for example, as oranges, may be conducted to wide bins suitably placed along the floor of a packing house so as to provide sufficient room at the sides of the bins for the fruit packers to work." [Transcript Record, page 518, lines 8-18.]

Another factor which he had in mind is thus set forth by Mr. Stebler:

"In packing fruit, such, for instance, as oranges, it is very desirable to have the sized or graded fruit delivered in wide bins, so that two or more packers may work at the side of each bin, as it has been found that where fruit is being separated or graded it is

liable to run mainly *to two or three different sizes*. It is much desired, therefore, to use wide bins which will enable two, or even more, packers to work at the side of a given bin in wrapping the fruit in papers and packing the same in the boxes.” [Lines 26-37.]

After these general statements of the objects of the invention we find Mr. Stebler, in his specification, states in what *in general* his invention consist. While in lines 55-57 Mr. Stebler refers to the “California grader” as an example of a grader which may be used; he distinctly says it is an example, and instead of limiting himself thereto or to any short or any sizer or length of grader specifically says “*or any other suitable grader.*” [Line 58.] The patent statute requires an inventor shall embody in his application for patent certain things. It does not require or permit him to describe or illustrate all the forms in which his invention may be used or embodied, but does require him to give to the public *the best form he then knows of*. Section 4888 of the Revised Statutes requires:

“In the case of a machine he shall explain the principle thereof and *the best mode* in which he has contemplated applying that principle. \* \* \*

According to said section, an inventor is only required to describe in his application for a patent, the “*best mode*” of embodying his idea of means in concrete form.

The patent office rules are to the same effect and the patent office does not require and does not permit an applicant for a patent to show, in his application, every possible form in which his invention can be embodied.



An inventor need only show in his patent his *preferred form* of embodiment of his invention. When he has done that, he is entitled to claim his actual invention in whatever form it can be embodied.

Complying with this requirement of the statute, Mr. Stebler referred to the best forms of grader elements then known to him, i. e., the "California" or Ish grader and the Robert Strain grader [Transcript Record, page 519, lines 48-55], and he described the best mode of embodiment of his invention to secure its fullest advantages. He showed that with his invention a very great longitudinal extension of the bin space could, if desired, be provided and utilized. It is clear, however, that he did not limit his statement of his invention to the particular form which he showed or described. His "specification" clearly discloses that he had more than one object in view and that he considered that more than one embodiment of his invention could be made. This is clear from the following portions of his patent specification:

"With these and such other objects in view as shall appear from the hereinafter contained description of the apparatus and its operation, the invention consists in the provision, in connection with a fruit sizer or grader such, for example, as the "California grader" of Letters Patent of the United States to James Ish No. 458,422, dated August 25, 1891, or any other suitable grader, of a horizontally traveling conveyer so arranged that the conveyer is tilted sidewise so as to extend slightly downward from the side of the grading or sizing machine, and in the provision, in

connection with such conveyer, of guiding means arranged along the conveyer and in suitable relation to the several grading discharges of the separating means as to form ways through which the separated fruit is carried by said conveyer and thereby delivered to suitable bins arranged below and along such conveyer.

“The invention consist further in the provision of means whereby such guiding means may be adjusted to deliver the given grade or size of fruit, either to any particular portion of the bin or to any one of several successive bins, so that in case the fruit being sized or graded runs very heavily of a given size or grade, such fruit may be delivered into a series of bins, thus enabling a large number of packers to have ready access to that size or grade of fruit and handle the fruit and pack the same as rapidly as graded or sized.

“A further object of the invention is to provide in connection with such fruit grader or sizer, and such conveyer and guiding means, removable and adjustable partitions in the bins so that the width thereof may be varied to suit the requirements.

*“By thus providing bins whose longitudinal extension may be adjusted with respect to the longitudinal extension of the conveyer of the distributing apparatus,* it is possible to provide the necessary bin room for all of the different sizes or grades of the fruit regardless of the run of the fruit. In packing oranges it is often found that the run of the fruit is particularly heavy to one or two given grades or sizes and it is essential in prac-

tical use to be able to provide sufficient bin room for the sizes or grades of which there are the greatest number of oranges in a given run. *This has been found to be one of the great difficulties which have heretofore existed with all apparatus where machinery has been used in sizing or grading oranges, and it is one of the important objects of this invention to provide means which will accomplish this result without interfering with the grading or sizing and at the same time permit the compact installation of the machinery and the ready access to the bin room by the packers.*

“Further objects and ends to be attained will be apparent from the construction and operation of my distributing apparatus as hereinafter described and shown in the drawings, wherein I have shown one embodiment of the invention, it being apparent *that many modifications may be made without departing from the spirit or scope of the invention.*”

Complainant submits that there is nothing in the Stebler specification which shows an intention on the part of Mr. Stebler to limit his invention to the employment of a short grader or sizer or a grader or sizer of any specific construction. In this connection the decision of this court in *Kings County Raisin & Fruit Co. v. U. S. Consolidated Raisin Company*, 182 Fed. 59, 63, is directly in point. This court says:

“It does not necessarily follow, from the fact that the claim describes a specific form of construction, that the inventor shall be limited to that form. All depends on his expressed intention, and the scope of the actual invention which he

has made. If his improvement is but a narrow one, or if *he has used language such as clearly to show his intention to limit his invention to a particular form described, then he is held to the language of his claim, and limited to that specific form.* But if his is a pioneer invention, or one of such merit as to be entitled to a liberal construction, the claim will not be thus limited, even if couched in specific language, unless the inventor has also shown his positive intention to relinquish to the public all other forms in which his invention might be embodied.

“Not only is there nothing in the specifications or claims to indicate that Pettitt intended to limit his claims to the precise form described, but the contrary is indicated by the terms of claim 18, and by the language of the specifications, in which it is stated that: ‘Various modifications might be made in the construction shown in the drawings and above particularly described, within the purview of my invention.’”

From the foregoing statements of the Stebler patent specification complainant submits that it is clear that Mr. Stebler distinctly recognized *and asserted* that one of the important objects of his invention was to provide means whereby the bin-space for a given grade or size of fruit might be adjusted to suit the run of the fruit and the guiding or delivery means also correspondingly adjusted to affect the delivery of the given size or grade of fruit to such enlarged bin. That this feature was entirely separate and distinct from any question of the relative lengths of the grader or sizer and of the bin space. That this feature of the

Stebler invention had to do solely with mutual adjustment of the bin and of the delivery of the fruit to the bin for a given size when the run of the fruit was heavy to that size. That it had to do with so accommodating the apparatus to the demands of the run of the fruit that where "the run of the fruit is particularly heavy to one or two given grades or sizes" the width of the bin spaces of those sizes may be altered or adjusted by the operator and the delivery means may also be correspondingly adjusted to deliver the fruit to such altered or adjusted bin space. It is, of course, obvious that if the run of the fruit is particularly heavy to one or two sizes of fruit, then the corresponding requirement for bin space for other sizes will be lessened and the bin spaces therefor can be altered by adjustment so as to cut off the unnecessary space from such bins and make it available for the "particularly heavy" sizes. This is in reality the main and most important purpose of the Stebler invention *and it is the very portion of the Stebler invention which has been appropriated by the defendant's machines.*

In passing, permit complainant to call the particular attention of the court to the fact that instead of Mr. Stebler limiting the statement of his invention during the prosecution of his application in the patent office, Mr. Stebler insisted upon the novelty, patentability, and importance of this very feature. Instead of being estopped to claim it, the record shows conclusively that he never conceded that it was not novel or patentable, nor did he accede to any rejection of any claim of this



feature. On the contrary this portion of the specification thus most clearly setting forth this object of the Stebler invention and insisting upon the allowance of the claims thereon, was inserted by the amendment of March 30, 1909 [Paper No. 7, Transcript of Record, page 609, see particularly first paragraph of page 610.] It is to be noted in this connection that after this insertion was made to the specification applicant *Stebler made no changes whatever in his claims*. He did not amend any of them thereafter. Instead of acquiescing in any rejection of the examiner, he appealed to the Board of Examiners-in-Chief and secured the allowance and grant of every claim he made at the time of the insertion of this matter into his application for patent. There clearly cannot be any estoppel against the very construction of the claims for which Mr. Stebler was contending in the patent office, and which claims were allowed and granted without subsequent amendment. Not only was this insertion made in the "specification" of Mr. Stebler's application, but the record shows that particular insistence was made upon this very feature of Mr. Stebler's invention (without regard to the length of the grader or sizing element compared to the length of the bin spaces) in the argument of Mr. Stebler to the patent office in submitting his application as thus amended. Mr. Stebler said:

"We call the examiner's particular attention to the feature of applicant's apparatus which provides the longitudinally adjustable bins in connection with the distributing apparatus. One of the particular features of this apparatus, and one upon which its commercial

value depends to a great extent, is the interrelation of the longitudinally adjustable fruit bins in connection with the adjustable guiding means on the conveyor. By these means, no matter what the run of fruit is, a sufficient bin space for the given sizes is always at hand. This is of extreme practical value in separating oranges according to their size, *and applicant is entitled to claims fully covering these features.*" [Transcript, page 612.]

Mr. Stebler never acquiesced in any rejection of the claim which he was thus setting forth. On the contrary, instead of acquiescing in such rejection and cancelling or restricting his claims, he appealed from the judgment of the examiner and it was reversed in his favor.

The foregoing, however, is not all the record evidence to show that Mr. Stebler, instead of limiting his claim of invention as asserted by defendant, continued to assert the novelty and importance of the feature referred to. By the same amendment of March 30, 1909, Mr. Stebler amended his specification by inserting the matter appearing in lines 53-63, page 520 of the transcript of record. This amendment appears in the last five lines of page 610 and the first six lines of page 611 of the transcript. By this statement Mr. Stebler further shows his insistence on the importance of this feature. This insertion was:

"By thus providing means whereby the longitudinal extension of the bins, with respect to the conveyor, may be adjusted to suit the run of the fruit, the bin room and the distribution of the sized fruit is wholly

within the control of the operator of the apparatus, and it is possible to so deliver the fruit that immediate and ready access can be had thereto by packers in sufficient number to readily and quickly handle and pack the sized fruit.”

Complainant submits, therefore, that there is absolutely nothing in the specification of the Stebler patent in suit upon which the lower court could have sustained a finding that Mr. Stebler intended to limit his claim to either the precise form described or to the use of a short grader or sizer or to the provision of the bin spaces extending out beyond or longer than the grader element. Defendant’s contention as to this is unsound.

It is true that Mr. Stebler recognizes, and the trade has recognized, that there is an additional advantage in extending the bin space beyond the length of the grader. This is not true in all cases, but it is true in a great many installations. But it is not necessary in order to constitute infringement that the infringing device shall be equally efficient with the best embodiment of the invention. It is well settled that:

“Infringement is not avoided by impairment of the functions of a patented device in degree, if the features are retained. *Murray v. Detroit Wire Spring Co.*, 206 Fed. 465; *Penfield v. Chambers*, 92 Fed. 630, 653.”

*Kawneer Mfg. Co. v. Toledo Co.*, 232, 362;  
*Murray v. Detroit Spring Mattress Co.*, 206 F.  
465.

The value of this relative adjustment of the bin partitions and of the delivery means on the conveyor

so that the bin spaces may be adjusted to take care of the run of the fruit, as before referred to, has been well recognized by the trade. *It is a feature which did not exist in the art prior to Mr. Stebler's invention, and it is a feature which has been appropriated by defendant in its machines.* In fact, defendant's machines embody both this feature of adjustable bin partitions in combination with the adjustment of the guiding means or delivery means on the conveyor *and* an extension of the bin space and conveyor longer than the grader element. In defendant's machines, as will be pointed out more clearly hereafter, the adjustable bin spaces and the conveyor are extended alongside the grader elements and to a point three feet nine inches beyond the extreme end of the last roller of the grader. This extension, however, is not simply three feet nine inches beyond the last roller of the grader, but as each of the rollers of the grader is forty-five inches long and the grading opening is formed at the forward or approach end of the roller and is only nine inches in length, the last grading opening is thirty-six inches short of the end of the grader element, thus making the extension of the bin spaces and conveyor six feet nine inches beyond the last grading opening. This gives six feet nine inches of bin spaces which may be arranged by means of the adjustable bin partitions as desired by the operator to take care of the different sizes of fruit. The operative result is that the several bin spaces may, by the operator, be so arranged that the bins to be occupied by the particular grades to which the fruit is running heavily may be adjusted so as

to occupy the required lengths of spaces and the extension of the bin space in defendant's machine is six feet nine inches for this purpose.

A reference to the proceedings in the patent office had upon Mr. Stebler's application for the patent in suit clearly shows that there is *no estoppel* upon the record against his asserting that he claimed this feature of the relative adjustment of the bin partitions and spaces in connection with the adjustment of the guiding and delivery means on the conveyor *regardless of the question of longitudinal extension of the distributing apparatus beyond the length of the grader element*. This record shows clearly that Mr. Stebler did not limit his claims to any details of construction or accede to any of the actions of the patent office in such manner as to be estopped from claiming a fairly liberal construction of his claims. It is true that the first five claims originally submitted in his application [Transcript Record, pages 580-581] were cancelled, but it is to be noted in this connection that instead of such claims being cancelled as unpatentable or anticipated, each of such claims was objected to by the examiner in his action [Transcript Record, page 583] because the claims were not *in good form*. The examiner objected to claim 1 because a bin was impliedly made part of the combination instead of being positively recited as an element. Claim 2 was rejected because it did not positively recite the grading element as an element of the claimed combination. The examiner objected to claim 3 and said it "requires recasting, much of the same matter being twice re-



cited." Claim 4 was objected to as it did not positively or directly recite either the grader or the bins as elements, and claim 5 was rejected as indefinite as to the adjustments. In this connection it will be noted that the examiner in this action did not reject either claim 2, 3, or 4 upon any prior patents and claim 5 was rejected as indefinite.

Turning now to Mr. Stebler's first amendment it is found [Transcript Record, page 586] that the claims were rewritten "*in view of the objection to the forms of the claims*" [line 6, page 586]. So it is found that instead of the original claims being rejected on the merits, objection was to the indefiniteness and form of the claims and they were required to be redrawn and Mr. Stebler did redraw these to avoid the formal objections of the examiner. It will be noted that the only claims thereafter cancelled were claims 5, 6, 7, and 8; that claims 1, 2, 3 and 11 as thus inserted by this first amendment are the correspondingly numbered claims of the patent in suit. They were never limited or amended in any manner. It will be found that claims 14, 15 and 19 were further inserted by subsequent amendments. [Transcript Record, pages 595 and 611.] All of these claims were rejected by the primary examiner, and Mr. Stebler, instead of acceding to such rejection and cancelling the same and being thereby estopped to assert such a scope of any claim covering precisely the same matter as any one of such cancelled claims, appealed to the Board of Examiners-in-Chief and secured the allowance of all these claims.

The rule of estoppel rests upon the proposition that the inventor "must be shown to have surrendered something which he now claims, in order to obtain that which was allowed."

Frey v. Marvel Auto Supply Co., 236 Fed. 919, 921;

Valvona-Marchiony v. Marchiony, 207 Fed. 380.

Referring to this proposition of limitation by proceedings in the patent office, the court in American Stove Co. v. Cleveland Foundry Co., 158 Fed. 978, says:

"It is a corollary of this proposition that if the applicant successfully defends his position and secures the assent thereto of those in the office having charge of the application, and the patent issues notwithstanding the objection which had at that time been urged, the patent is not subject to diminution on that account."

This whole question of such estoppel or abandonment is summed up by the court in Victor Talking Machine Co. v. American Graphophone Co., 151 Fed. 601, as follows:

"But when his claims are rejected on references cited against them, he is called upon to exercise his election *between insistence and appeal, or desistence and acquiescence*, and, if he acquiesces the public is entitled to the benefit of the limitations and admissions imposed upon him as a condition precedent to the allowance of his patent."

While it is clear that there is no estoppel whatever arising from the patent office record, yet even such

estoppel could not affect either the question of Mr. Stebler having claimed the combination of a grader element, a longitudinally moving conveyor arranged at the side of such grading element to receive fruit therefrom, the adjustable guiding means of such conveyor, and the adjustable bin apparatus arranged at the sides of and below such conveyor. This rule of estoppel referred to by defendant is only and solely from maintaining that an amended claim substituted for a rejected and cancelled claim covers the devices disclosed in the references cited by the patent office examiner, which the examiner believed were within the limits of the claims as rejected. That this is the true rule, see:

National Hollow B. B. Co. v. Interchangeable Co., 106 Fed. 714;

Weber Electric Co. v. Union Electric Co., 226 Fed. 482, 485;

National Gas & Electric Fixture Co. Case, 204 Fed. 79, 83;

Heywood Bros. & Wakefield Co. v. Syracuse Co., 152 Fed. 453;

Drum v. Turner, 219 Fed. 191;

Hess-Bright Co. v. Fitchel, 219 Fed. 723;

J. L. Owens Co. v. Twin City Separator Co., 169 Fed. 259-268.

As said in the latter case:

“He is not estopped from claiming and securing by an amended claim every improvement and combination he has invented that was not disclosed by the references upon which its original claim was rejected.”

In passing we desire to call the attention of the court to the fact that such an estoppel as asserted by defendant does not run against the application of the doctrine of equivalency to the claim as allowed.

Weber Electric Co. v. Union Electric Co., 226  
Fed. 482-485;

Heywood Bros. & Wakefield Co. v. Syracuse  
Co., 152 Fed. 453;

J. L. Owens Co. v. Twin City Separator Co.,  
168 Fed. 259-278.

As said in 152 Fed. 453, above:

“While it is settled law that a patentee who has acquiesced in the rejection of a broad claim by substituting a narrower one cannot insist upon a construction of the latter to cover that which was rejected, yet such rule does not debar him from a liberal construction of the claim as amended nor from the benefit of the doctrine of equivalents.”

If the contention of the defendant in this case as to the effect of the amendments of claims or the cancellation of too broad claims and the revision of claims, could be sustained to the extent of prohibiting the patentee in all cases from claiming any benefit of the doctrine of equivalency, then practically no claim of any patent would be entitled to any application of such doctrine of equivalency, for substantially every claim as first submitted to the patent office is found to be too broad and must be revised to bring out the true invention—the real novelty.

The attention of the court is most respectfully called

to the carefully prepared briefs and arguments submitted by Mr. Stebler, both to the primary examiner during the prosecution of his application for the patent in suit, and to the Board of Examiners-in-Chief upon the appeal. [See particularly Transcript of Record, pages 600-609, 612, 613, 617 to 634, 650 to 674.]

It is impossible to find any admission in any of these arguments that the Stebler invention was limited to the distributing conveyor or the bin spaces being extended longer than the grader. Nowhere in any of these proceedings can it be pointed out where Mr. Stebler acceded to the examiner in any rejection of that portion of Mr. Stebler's claim which was addressed to the general combination of a fruit grader and a conveyor in combination with both adjustable guiding or delivery means and adjustable bin partitions so as to effect the result and advantage so fully and completely described and set forth in Mr. Stebler's specification.

The decision of the Board of Examiners-in-Chief [Transcript Record, pages 675-677] does not show that the claims of the Stebler application were solely allowed upon the ground that the longitudinal extension of the delivery portion of the distributing means was greater than the longitudinal extension of the grading element. In the first place it is to be noted from the decision of the appeal board [Record page 676] that the first reason given why Rayburn patent fails to meet the claim is "*that the distributing means is not 'traveling'*". In other words, the Rayburn device



was the arrangement of a grader or sizer element high above the floor with spouts leading from each grading opening or discharge opening down to the main floor level and to the given bin spaces. This machine depended entirely upon gravity and required the utilization of a vast amount of floor space of the packing house. With the Rayburn conception the bins are arranged so that packers may be employed at both sides of the bins, but there is no suggestion even of adjustable bin partitions to adjust the width of the bins. This was not Rayburn's concept. His concept was to provide very large bins upon the floor so arranged that the packers could have access to both sides of the bins. It would be as fair to the Board of Examiners-in-Chief to say that they utterly disregarded this lack of adjustability of the bin partitions as it is to say that they allowed Mr. Stebler's claims solely upon their second statement of difference and did not base their opinion and action at all upon their specific finding that "*Rayburn fails to meet the claim, however, in that his distributing means is not 'traveling'.*".

In this connection we point out the fact that the *Thomas Strain* patent, so much relied upon by defendant, was also before the Board of Examiners-in-Chief and they held that it does not anticipate any of the claims of the Stebler patent.

The decision of the Board of Examiners-in-Chief was in favor of Mr. Stebler. Their action allowed all of his claims. There could be no estoppel against Mr. Stebler because of anything that the board might have failed to specifically mention in his favor or in

favor of any of his contentions where their action was to allow all of his claims, thus ending, so far as the patent office was concerned, any chance of his making any further assertions as to either the scope of the claims or the interpretation thereof. If the board only gave part of the reasons why the claims were allowable, that could not affect an estoppel against Mr. Stebler in view of the fact that they did not deny patentability upon other grounds. So that, however the decision of the board is viewed, no estoppel can arise therefrom.

There is nothing in the prosecution of the Stebler application before the patent office or in the claims allowed which indicates that the contract made between the Government and complainant was that complainant's patent should be limited to the particular or specific construction of the elements shown or described by him. In fact the Stebler invention does not inhere in the particular or specific construction of the elements. It is immaterial, for instance, what be the particular construction or type of fruit sizer or grader that is used so long as it is a grader which discharges through successive grade openings so that the combined mode of operation of the apparatus remains substantially unchanged. Likewise, it is immaterial what the particular construction be of the guiding means. It is perfectly apparent that it is immaterial to the inventive idea expressed in the Stebler patent whether such guide means be pivoted at their upper ends or whether they be in any other manner simply fastened or held in place either at their ends or inter-

mediate portions. It is also apparent that it is immaterial whether these guiding means be telescopic so as to be extensible by merely pulling one part out from the other or whether the same practical result be secured by simply putting in place an additional guide piece or barrier.

The invention produced by Mr. Stebler did not consist in pivoting the ends of the guides or barriers or in making the same telescopic. The invention was in the broad combination and not in the details of construction of the elements. It will be found that none of the claims relied upon set forth or specify either of these features and it is clear that they are not limited thereto, but cover not simply the particular construction of elements shown and described by Mr. Stebler but the mechanical equivalents thereof. The intention on the part of Mr. Stebler not to so limit himself is apparent from the statement in his specification hereinbefore referred to wherein he states that he has "shown one embodiment of the invention, it being apparent that many modifications may be made without departing from the spirit or scope of the invention." [Transcript Record, page 519, lines 8-13.]

There is, however, another serious error in defendant's contention that the Stebler patent is limited to the longitudinal extension of the delivery portion of the distributing means being greater than the longitudinal extension of the grading element. Defendant's argument totally overlooks the fact that *claim 11* of the Stebler patent was allowed by the primary examiner, and claim 11 is one of the claims in particular

which brings out the combination which effects the purpose and object of Mr. Stebler set forth in lines 70 to 104, column 2 [Transcript Record, page 518], of the Stebler patent specification. This 11th claim is as follows:

“11. The combination of a fruit grading element and a series of bins, the walls of said bins being adjustable longitudinally of the series, and a distributing apparatus comprising a conveyor traveling longitudinally between the fruit grading element and the bins, and guide means arranged along the conveyor and forming chutes for guiding the fruit from said conveyor to said bins, said guide means being adjustable to shift the longitudinal position of their outer ends in accordance with the longitudinal positions of the walls of the bins.”

It is to be noted in this connection that this claim is not limited to any particular details of construction of the grading element or of the series of bins, except that the walls of said bins shall be adjustable longitudinally of the series, or to any details of the distributing apparatus, except that the same shall comprise a belt or conveyor traveling longitudinally between the fruit grading element and the bins and shall comprise guide means arranged along the conveyor and forming chutes for guiding the fruit from said conveyor to said bins, said guide means being adjustable to shift the longitudinal position of their outer ends in accordance with the longitudinal positions of the walls of the bins. This is a broad claim upon the general combination. It is clear that it is imma-

terial, insofar as the scope of this claim is concerned, whether the particular guide means be pivoted or otherwise held or mounted or “arranged” along the conveyor.

The claim does not specify that these guide means must be pivoted. This claim is broadly worded in saying that the guide means are adjustable “to shift the longitudinal position of their outer ends.”

In defendant’s machine the “barriers,” as shown by the evidence, are held in place by rods or bolts which extend down through the slot loosely holding the barriers in position so that they may be slid longitudinally of the conveyor belts so as to adjust the outer or delivery ends in accordance with the adjustment of the bin partitions.

It is to be noted that this 11th claim does not limit the guide means to being telescopic, and it is clear that the pulling out of one portion of such telescopic guides from within the other performs identically the same result as does the putting in place of another or additional barrier in the slots in defendant’s machine.

We thus see that even the primary examiner of the patent office allowed this general combination claim of applicant’s, and that in no manner does it specify that the bin capacity shall be extended longer than the grading element. It is to be noted that this 11th claim was submitted by the first amendment [Transcript Record, pages 584-588] i. e., when the original five claims were cancelled “in view of the objections to the form of the claims.” It is also to be noted that no amendment or limitation was ever placed upon this



claim. It was allowed as submitted, so that there is nothing upon which defendant's contention of estoppel can act.

If complainant had acceded to the rejection by the primary examiner and cancelled all the other claims, standing solely upon this 11th claim, still he would have been entitled to the interpretation thereof in the scope now asserted by complainant, and defendant's machine would have been an infringement thereof.

While claims 1, 3, 5, 7, 15 and 17 specify that the longitudinal extension of the distributing means shall be greater than the longitudinal extension of the grading element, or convey by other words the fact that the conveyor is of greater length than the grader, it is to be noted that claims 2, 6, 8, 11, 14 and 19 do not contain any such limitations. No rule of construction is better settled than that a limitation appearing in one claim and not appearing in another shall not be read into such other. The effect of such interpolation would be to make the two claims duplicates. The fact that one of the claims specifies that the conveyor or belt shall be "of greater length than said grader" (claim 7) or that the series of bins shall have "longitudinal extension greater than the longitudinal extension of the grader" (claim 5) and another claim is allowed or granted which does not contain such limiting phrase specifying such construction, is conclusive that such latter claim is not limited in its scope to such a construction or interrelation of parts as to require a machine, to be an infringement thereof, to

have such longitudinal extension. On the contrary, the presence of such different claims conclusively negatives any possibility of reading any such limitation into the latter claim. It therefore follows that claims 2, 6, 8, 11, 14 and 19 are not and cannot be limited in this manner.

A most careful analysis of the proceedings in the patent office, as well as a comparison of the various claims of the Stebler patent, therefore, discloses most fully and completely that instead of Mr. Stebler intentionally limiting his patent to the use of a short grader or sizer, or to the extension of the bin spaces or of the conveyor to a greater length than the length of the grader or sizer, both Mr. Stebler intended to claim, and the patent office intended to allow and did allow Mr. Stebler to claim, his invention without limiting the patent to such longitudinal extension feature and that defendant's contention in this regard is wholly unsupported and cannot be sustained. In view of the presentation of this appeal upon the argument in the court, and by appellant's brief, complainant might rest here as defendant admits that all the claims are valid and has sought to show non-infringement solely by this assertion. We do not understand that defendant denies that in all of defendant's machines the bin partitions are adjustable at the will of the operator longitudinally of the conveyor belts and of the grader. As to this there is no issue in the case. Nor do we understand that defendant contends that with any of its machines it cannot, or does not, by the use of the proper "barriers" placed along its distributing or conveying belts

carry the sized or separated fruit from one grade-opening, through which the fruit is running heavy, to a second bin or to a bin the partition of which has been adjusted longitudinally to provide an extra wide bin space, in substantially the same manner as disclosed in the Stebler patent. After hearing all the oral evidence and after twice inspecting defendant's machines in actual use the District Court has found these facts against defendant.

At the oral argument in this court defendant harped upon the fact that in the drawings of the Stebler patent the guiding means on the conveyor belt were illustrated as directed transversely of the surface of the belt and upon the fact that the position of the barriers in the photo of defendant's machines [Plaintiff's Exhibit 5, Transcript Record, page 538] showed a position of such barriers not in fact ever used by defendant. It is true that the position of the three barrier pieces shown at the left-hand side of the distributing system (in this photo) were placed in that position by plaintiff's attorney. They were so placed, as is shown by the evidence and as was understood by the trial court, to illustrate one of the many adjustments that could be made of defendant's barrier pieces. Defendant's witnesses have testified that they never in fact have used this adjustment, and it was for this reason that the claims of the Stebler patent which were limited to the barriers or guiding means extending transversely of the conveyor belt were held not to be infringed by the court. The court did not agree with complainant that inasmuch as these barrier pieces could

be arranged in this manner plaintiff was entitled to an injunction restraining the defendant from making use of this arrangement. Complainant still believes that it was entitled to an injunction which would prevent the defendant utilizing such an adjustment of its barrier pieces. Under the well known rule of law that, where a device is capable of a given use and so constructed that it can be used in such a manner, complainant is entitled to be protected against such an infringing use. However, it is to be noted that while claims 4, 12, 16, 17, 18 and 20 of the Stebler patent are limited to the arrangement of the guiding means or barriers transverse to the distributing belt this is not a limitation or an element of the claims which have been decreed infringed. Inasmuch as claims 4, 12, 16, 17, 18 and 20 specifically call for this transverse arrangement and the other claims do not, under the rule of interpretation, the other claims are not to be limited to such transverse arrangement. Such a limitation appearing in one claim is evidence that the other claim or claims not containing such a limitation are not to be so limited.

Defendant does not contend that it has shown anticipation of any of the claims of the Stebler patent. Defendant concedes that the same are valid and cover patentable and novel subject matter. It does refer to and depend upon certain prior art which it contends limits the scope of the claims. It is to be noted, however, that all of this prior art was before the patent office with two exceptions. The first of these exceptions is the so-called "camel back" arrangement and the other is the Beekhuis patent and installation at Hanford.

It is admitted that the "camel back" was purely a gravity arrangement. It is true that it was in use long prior to the Stebler invention. It was to displace the "camel back" and obviate the serious objections thereto that the Stebler invention was produced. It is to be noted in this connection that defendant does not use the "camel back" arrangement. With the "camel back" arrangement the grader must be arranged much above the bin spaces and a very great waste of the room of the packing floor must occur. While with the apparatus of the Stebler invention the floor space is very much conserved and it is to secure this same conservation of packing house floor space that defendant has adopted the Stebler invention.

It is also to be noted that there was not present in this "camel back" arrangement even the general idea of means utilized by Mr. Stebler. Neither the conveyor nor traveling belt, nor the adjustable guiding means of such belt, nor the adjustable bin partitions with their mutuality of adjustment in accordance with the adjustment of the guiding means were present in this "camel back" arrangement. It is clear that the result secured by the Stebler invention and by the defendant's machines could not be secured in this "camel back" arrangement. The Stebler invention over the "camel back" arrangement did not pertain simply to improvements in details of construction, but to an entirely novel arrangement of the general elements used, and the "camel back" does not limit the Stebler claims in any manner.

It is to be noted that every one of the claims of the Stebler patent calls for the *traveling conveyor*



which is the essential difference in the principle of action of the Stebler apparatus from the "camel back." In fact the "camel back" arrangement to a great extent was merely an early form of the distributing system of the Rayburn patent No. 741,928 which was before the patent office.

The evidence conclusively shows that these "camel back" installations and the installations of the Rayburn overhead system of the Rayburn patent No. 741,928 were in common and general use for years prior to the Stebler invention, and it was these very objections to the "Rayburn overhead" or "camel back" apparatus that lead Mr. Stebler to the conception and production of his invention. The evidence conclusively shows that after Mr. Stebler produced the invention of the patent in suit not a single one of the Rayburn overhead systems or a single "camel back" system was ever installed. On the contrary every one of these systems, with the possible exception of one, has been displaced by the Stebler distributing apparatus of the patent in suit.

The Beekhuis patent and the Beekhuis installation at Hanford are open to the same objections that exist in the "camel back" and Rayburn apparatus. It is true that the Beekhuis patent shows a long carrier belt running along the side of the grader, but it does not show bin spaces arranged along the side of the conveyor, nor the interrelation of adjustment of the partitions of the bin spaces in accordance with the adjustment of the guiding or barrier means on the belt. With the Beekhuis arrangement cross belts are ar-

ranged at intervals along the conveyor belt. These cross belts lead to tables where the operator may peel or pit the peaches which have been graded. With the Beekhuis device, if you cut out one of the cross belts from operation with a given grade by closing the switch 11 [Transcript Record, page 99] the belt will carry the fruit from the grade opening 15 at the right, for example, to the next cross belt or to which it is deflected by the given switch arm 11. What then is to be done with the size or grade of fruit which was being delivered to the cross belt to which this grade has just been delivered? Either these two grades must be mixed on this cross belt or the delivery of each grade advanced one belt, in which case you have no place where you can deliver the last or given grade. This device lacks entirely the fundamental idea of adjustment of the bin space for the access of the packers. It is simply and purely a conveyor. It has the same fundamental objection that there was to the Rayburn and "camel back" arrangement in requiring very great packing house floor room. To avoid this waste of space is one of the objects of the Stebler invention. It is clear that this Beekhuis apparatus does not respond either to the spirit or letter of any of the claims of the Stebler patent, and it could not be used to effect the result sought and accomplished by the Stebler invention or by the defendant's device. In this connection the language of the Supreme Court in the Rubber Tire case (220 U. S. 444) is very much in point:

"The prior art was open to the rubber company. That 'art was crowded,' it says, 'with

numerous prototypes and predecessors of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. *And yet the rubber company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done."*

Doubtless this Beekhuis patent and installation are referred to mainly by defendant because it has in it something which approximates the use of the longitudinally extending conveyor, but most certainly it fails utterly to show a combination in which the "guiding means may be adjusted to deliver the common grade or size of fruit, either to any particular portion of the bin or to any one of several successive bins, so that in case the fruit being sized or graded runs very heavily of a given size or grade, such fruit may be delivered into a series of bins, thus enabling a large number of packers to have ready access to that size or grade of fruit and handle the same and pack the same as rapidly as graded or sized" and to "provide in connection with such fruit grader or sizer, and such conveyor and guiding means, removable and adjustable partitions in the bins so that the width thereof may be varied to suit the requirements." [Stebler patent specification, Transcript Record, page 518, lines 71-88.]

The features thus referred to are claimed in combination in the Stebler patent and they do not exist in such combination in the Beekhuis device or apparatus. The difference between the Stebler apparatus and the Beekhuis apparatus does not exist in the details

of the pivoting of the guiding means or barriers, nor in the particular means of holding or fastening the adjustable bin partitions. On the contrary it exists in the provision of the combination of adjustable barriers or guiding means and the adjustable bin partitions in combination with the grader and the conveyor or distributing belt or belts. This Beekhuis patent and installation simply serve in this case as an illustration of the fact that the Stebler invention is not limited to the details of pivoting the barrier means, but, on the contrary, exists in the broad idea of these interrelated means.

This court, in the case of *Detroit Copper Mining Co. v. Mine & Smelter Co.*, 215 Fed. 103, opinion by Circuit Judge Gilbert, said:

“When the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the stance of the invention. *Winans v. Denmead*, 15 Howard 330; *Metallic Extraction Co. v. Brown*, 104 Fed. 345; *Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co.*, 132 Fed. 614.

“The riffles in the Deister table, used by the appellants, differ from those of the Wilfley table in that each alternate riffle terminates with minute and slightly deflected ends, which have an elevation of but one thirty-second of an inch, so that at the conclusion of the separation the material is discharged into the open spaces between them. If the deflected ends were removed, there would remain a table having riffles with advancing terminals, as in the Wilfley table. We are of the opinion that the use of these deflected terminals

so greatly reduced in elevation does not serve to differentiate the Deister table from that of the patent in suit, whether the spaces covered by them be regarded as substantially a smooth surface, as was held in *Wilfley v. Denver Engineering Works Co.*, 11 Fed. 760, and in *Mine & Smelters Supply Co. v. Braeckel Concentrator Co.*, 107 Fed. 897, or whether they be regarded as a continuation of the riffles. There is presented in either view a table with riffles terminating in a diagonal course with reference to their general direction, a course which is essential to the successful operation of either table, *and thereby the appellants have availed themselves of the distinctive feature of the Wilfley table, and therewith they have performed the same function by the same means, and in substantially the same manner, as in the Wilfley combination.*”

Defendant's machine does not depend on the action of gravity alone, as in the “camel back” or the Rayburn devices or upon the additional conveying belts arranged at right angles to the main conveying belts and onto which separated grades or sizes of fruit are shunted and are thereby conveyed, as in the Beekhuis. On the contrary defendant's machines appropriate the organization and inventive concept of Mr. Stebler and do away with the waste of floor space attendant to these prior constructions. Defendant's machines embody the Stebler idea of interrelated adjustment of the bin partitions arranged along the conveyor or distributing belts and the adjustment at the will of the operator of the discharge from the guiding means or barrier. Defendant's machines oppose the gravity



operation of the "camel back" and "Rayburn" devices by guiding means or barriers and convey the fruit along these guiding means or barriers identically as does Mr. Stebler's preferred form of the embodiment of his invention.

As said by this court in *Stebler v. Riverside Heights Association*, 205 Fed. 735:

"The question is, not whether the addition is material, or the omission is material, but *whether what has been taken is the substance of the invention.*"

As said in *Eck v. Kutz*, 152 Fed. 758:

"The question is whether *the inventive idea* expressed in the patent has been appropriated; and, if it has, infringement has been made out."

The utter lack of the idea of corresponding adjustment, of the delivery of the fruit and of the bin spaces therefor, along the traveling conveyor in these prior "camel back," "Rayburn" and "Beekhuis" devices shows that the Stebler invention was not in details of construction. That the inventive idea expressed in the Stebler patent was much broader than mere details of construction. Mr. Stebler produces a substantially new mode of operation and defendant instead of keeping to the old appropriated Mr. Stebler's concept.

Defendant has devoted a considerable effort to limit the scope of the Stebler invention by means of the disclosure of the Thomas Strain patent No. 775,015, but it is to be noted that defendant has entirely omitted to particularly point out the fact that this

Thomas Strain patent utterly lacks the idea of the Stebler invention. In the first place, and primarily, *Thomas Strain had no conception whatever of adjusting his bin partitions or the combination of the adjustment of the delivery of the fruit in accordance with the adjustment of the bin partitions.*

This Thomas Strain patent is the subject of complainant's suit against the defendant for infringement thereof by these same machines in the case of Stebler v. Porterville Citrus Association appeal No. 3052 in this court and submitted upon this same record.

With the particular form of grading element illustrated in this Thomas Strain patent and consisting of the flexible rod and the traveling belt there are no definitely defined grade openings through which *a definite size* of fruit, and *that size only*, is discharged. On the contrary as the grading rod 20 is inclined to the longitudinal extensions of the grading belt, the opening formed therebetween is constantly increasing so that to a given bin the sizes of the fruit vary slightly and it is necessary in order with such machine to have an even, or approximately even, pack of fruit in the boxes to average up the fruit in the bin. Mr. Strain proposed to do this by mixing the fruit delivered through the discharge aperture opposite a given bin, and for this purpose provided the portion of the apparatus referred to by counsel for defendant. In this connection it is to be borne in mind that Thomas Strain did not provide a distributing belt or conveyor in the sense of the Stebler invention, or of the defendant's distributing belts. The

feature referred to by defendant in the Thomas Strain patent, and the one to which we now refer, is in connection *with a portion of the side or edge of the grading belt.*

Mr. Strain says in his specification:

“36a represents brackets attached to the edges of the leaves. Mounted on each bracket is an inclined deflector 36b. The deflector 36b is provided with a lug 36c, and the latter is adjustably mounted on the bracket 36a and clamped thereto by means of a set-screw 36d. The deflector 36b may be placed at any desired point along the bracket 36a, so that fruit will be shunted into the bin at any desired point. This allows the fruit to be delivered into the bin in such a way that it is thoroughly mixed. *If the fruit were delivered into the bin direct from under the grading-rods, the size of fruit in the bin at one extreme side would be larger than the size at the other side.* To obviate this difficulty, I employ the guards 36 and deflector 36b, *by means of which the fruit is thoroughly mixed in the bin,* and no particular size occupies a particular place in the bin, as would be the case were the guards and deflectors not employed.” [Transcript Record, page 529, lines 65 to 85, column 2, Strain patent specification.]

It is thus seen that the object and purpose of the Strain deflecting means is totally distinct and separate from the purpose for which Mr. Stebler designed his combination with the conveyor belt and the adjustable guiding means and adjustable bin partitions.

Defendant contends that the purpose of its distributing belts and guiding means is the same as that of the Thomas Strain patent *and that alone*. This question of fact was determined adversely to defendant by the trial court not only upon the oral evidence produced in open court, but upon the evidence of the actual machines in actual use as shown to the court as a part of the proofs on the trial of this cause.

A careful examination of the descriptive portion of the drawings of the Thomas Strain patent shows conclusively that the “deflector 36b” cannot be moved so as to carry its point of discharge to an adjoining bin, but that, as stated in the Strain specification, its limit is to “any desired point along the bracket 36a, so that fruit will be shunted into *the* bin at any desired point.” Mr. Strain’s purpose of this is further adverted to in the statemetn of the objects of his invention. He says:

“Another object of my invention *is to provide means whereby the fruit will be thoroughly mixed or delivered*, into each bin in such a way *that the several sizes of fruit in each bin* are perfectly distributed. This is a valuable feature, for the reason that although the average size of fruit in different bins will vary, still the actual size of fruit delivered into each bin will also vary somewhat.” [Transcript Record, page 528, lines 13-21.]

A reference to the specification shows that there is no description whatever of the bins. They are referred to simply as “proper bins” [Transcript Record, page

529, line 62] and as “suitable bins.” [Transcript Record, page 529, lines 87-88; and page 530, line 56.]

We thus see that the statement in defendant’s brief that “Inasmuch as these co-acting members 36 and 36b are arranged longitudinally of the grading apparatus and parallel with the endless traveling belt or carrier 10, they form throughout the length of the apparatus a series of chutes for guiding the sized fruit and directing the same *to any desired discharge point* relative to the fruit receiving bins” is totally erroneous. If the statement is limited to directing the sized fruit to any desired portion of the space *within a fixed bin* and for the purpose of intermingling or mixing the fruit then its applicability is apparent.

In defendant’s brief appears a lengthy quotation from the testimony of Thomas Strain. Of course it is impossible to produce before this court the appearance or demeanor of Mr. Strain upon the stand. He was a witness who was very hostile to the complainant. This was very apparent from his demeanor. Not only was this apparent, but the manner of his examination and the manner in which he answered the questions asked him were such that it was apparent to the court that this Thomas Strain patent subject matter had practically passed out of his mind. He showed an absolute inability to follow the drawings of the patent or explain it. His testimony, as quoted on pages 34, 35 of the defendant’s brief, is shown to be absurd if given the meaning placed thereon by defendant when it is borne in mind that if the “deflector 36b” were moved so as to be in a position to vary the distribution



of the fruit from one bin to an adjacent bin, the upper horizontal or straight portion would come directly in the path of the fruit coming out of that compartment or portion of the grader and block it from egress so that it could not be discharged. But there is another difficulty with attempting to so use the Strain deflector. Granting, for the sake of argument, that it could be so used, which it cannot. If so positioned in the machine you would then mix your sizes of fruit and the average of the bin into which you were delivering would not be true to the given size for packing. So that, which ever way this matter is approached, the Strain device is incapable of producing the desired result of changing the delivery from one bin to an adjacent bin and the Strain patent description has no suggestion even of a coincident adjustment of the width of the bin with the adjustment of the point of delivery. It is for these reasons that the board of appeals says in its opinion:

“The distributing means of White and Strain are clearly inapt for applicant’s device, and in order to be used therewith would require such modification as to entirely lose their identity.” [Transcript Record, page 676.]

This purpose so referred to by the Court of Appeals has been heretofore pointed out from the Stebler specification and is to provide bins whose longitudinal extension may be adjusted with respect to the longitudinal extension of the conveyor of the distributing apparatus so that it is possible to provide the necessary bin room where the run of the fruit is particularly

heavy to one or two given grades or sizes, etc. The lack of correspondence of the Thomas Strain conception is apparent and the correspondence of the function and mode of operation of the devices of the defendant's machine to the Stebler conception is apparent. So, again, we have the defendant giving his praise to the prior art and imitating the plaintiff's patent.

Defendant states that it does not claim that any of the claims of the Stebler patent are anticipated. On the contrary it specifically admits the validity of each and every of such claims. It says that it cites this prior art for the purpose of limiting the scope and interpretation of the Stebler claims. Yet, as it has been pointed out, the Stebler claims were not allowed upon account of the specific form of the guiding means, to-wit, the telescopic feature, or the pivoting of one end. This is clearly shown by the fact that such features are in no manner or wise mentioned in either the argument before the primary examiner or before the Board of Examiners-in-Chief in Stebler's presentation of his application for patent, nor are these details of construction mentioned in the opinion or decision of the Board of Examiners-in-Chief. Both Mr. Stebler asserted, and the board of appeals found, that the Stebler invention was much broader than these details of construction.

The defendant harps very much upon the term "chute" as used in the claims and seeks by a play upon this word to argue non-infringement. It must be remembered that Mr. Stebler in his patent does not limit himself to the transverse inclination of his distributing

belt. Within the terms of his invention such belt may run flat, in which latter case both sides of his barriers or guiding means may at times come in contact with the fruit, but where he uses the inclined arrangement of the distributing belt, as shown in the preferred form of his invention in the drawings of his patent, the chute along which the fruit runs is formed by the belt and the upper surface or face of the guides against which the fruit bears by gravity. The term "chute" in this sense is broad and generic. Everyone is familiar with the common chute which consists of simply two pieces of material set at right angles to each other and forming a V-shaped chute or trough. Three sides are not required to form a chute. In fact this play upon words is the same defense and literal construction which defendant attempted to place upon the claims of the Robert Strain reissue patent in *Stebler v. Riverside Heights Orange Growers' Association* and which was denied by this court in its opinion in 205 Fed. 735. It is directly opposed to the decision of the Supreme Court in *Bates v. Coe*, 98 U. S. 31:

"Sufficient has already been remarked to show that the invention, in its primary feature, is an improved machine for drilling, composed of the devices pointed out in the specification, which operate and perform the functions therein described, and which by their joint operation in the manner described accomplish the patented result.

"Where there is only one combination of an entire character, incapable of division or separate

use, the defenses of the kind mentioned must be addressed to the invention.

“Devices in one machine may be called by the same name as those contained in another, and yet they may be quite unlike, in the sense of the patent law, in a case where those in one of the machines perform different functions from those in the other. *In determining about similarities and differences, courts of justice are not governed merely by the names of things, but they look at the machines and their devices in the light of what they do or what office or function they perform, and how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the same result; and that devices are substantially different when they perform different duties in a substantially different way, or produce substantially a different result.* Cahoon v. Ring, 1 Cliff. 620.”

As said by the Circuit Court of Appeals for the Second Circuit in *Carlson Motor & Truck Co. v. Maxwell Briscoe Motor Co.*, 197 Fed. 309, 315:

“The question is not one of nomenclature, but of mechanics and relates not to the names given to the parts of the combination, but to the various functions they perform.”

At the argument of this appeal defendant's counsel attempted to lead this court to believe that complainant and complainant's counsel had attempted to mislead and had mislead the trial judge as to the defendant's machines and their mode of operation. In its brief on this appeal defendant says:

“We cannot refrain from criticizing the manner in which appellee endeavored to mislead the lower court as to an understanding of the operation of the appellant’s machine, so far as relates to the operation of the claimed distributing feature of the apparatus, the said apparatus being illustrated by Complainant’s Photo Exhibits 4, 5, 6, 7 and 8.” (Def’t’s Brief, page 68.)

Again defendant says (Brief, page 89):

“There has been no testimony presented other than the incorrect Photo Exhibit No. 5, for the establishment of a charge of infringement.”

In this connection defendant urges the rule that the burden of proving infringement rests in the first instance upon the plaintiff. But defendant ignores the rule that a party who seeks in an appellate court to review and reverse a finding of fact must present to the appellate court *all the proofs* upon which the lower court passed judgment. It was defendant’s duty to place this court in the possession of the evidence. That plaintiff could have mislead the trial judge who twice, for the very purpose of ascertaining the mode of operation and the mechanisms of defendant’s machines, in the presence of counsel for both parties and in the presence of both parties, inspected defendant’s machines in actual service and at the same time compared the same with the Stebler machines in actual service, is absurd. Necessarily the findings of the lower court are based not simply upon the oral evidence, but upon this *best proof*, i. e., the actual



machines in commercial operation by the defendant. It does not set well for defendant to slur either complainant or his counsel under such circumstances.

Defendant summarizes its claim of non-infringement on page 79 of its brief. It is predicated upon the false and unsustained contention that the defendant's fruit bins are not extended beyond the fruit sizer. It overlooks and ignores totally the fact that the Stebler invention was not limited to such an extension and it also overlooks and ignores the true facts regarding defendant's machines,—they are extended three feet nine inches from the end of the last grader section to the end of the distributing belts,—seventy-eight inches,—six feet six inches beyond the last grading opening. The fruit from the last grading opening in defendant's machine may readily be directed and conveyed on the distributing belts and barriers to the extreme end of this six foot six inch extension or to any part thereof, whenever occasion requires, to-wit, when the run of fruit is extra heavy to that particular size. This is the same function as in the Stebler apparatus.

The third differentiation made by defendant between its machines and the Stebler patent construction is that in defendant's machines there are no "chutes" disposed *diagonally* of the conveyor. This is completely disposed of by observation that none of the claims found to be infringed are limited to such diagonal or transverse arrangement of the guiding barriers on the distributing belt.

The fourth attempted differentiation is defendant's

play on the word “chutes” and a reiteration of this same alleged limitation to *diagonal* arrangement.

The fifth attempted differentiation is the allegation that “in the appellant’s machine the normal working thereof is without the employment of the longitudinally adjustable barriers.” This may be sufficiently answered by adverting to the fact that the court has only enjoined the use of the barriers in combination with the other elements of the machine. Defendant may still use its machines in what it thus contends is their “normal working.” But complainant is entitled to enjoin any use thereof which includes the combination invented and produced by him and covered by his patent.

In this summary of defendant’s brief we do not find any substantial error, even from defendant’s standpoint, in any of the court’s findings of fact. This summary does not allege that the lower court was in error in finding that in defendant’s machines they had so interrelated the adjustability of the barriers and the adjustable bin partition, that the novel result sought for and obtained by the Stebler invention could be secured, and this cannot be denied. This is the fact that the lower court found against defendant and it is the fact upon which the decree of infringement substantially rests. It is a fact which is not denied by defendant. It is a fact which is apparent upon a correct understanding of the photographs, Complainant’s Exhibits 4, 5, 6, 7, and 8; of the testimony of complainant’s witnesses Stebler and Knight. It is to be noted that Complainant’s Exhibits 4 and 8 each shows

three distributing belts, and Plaintiff's Exhibit 5 two. With the various slots above and below each of these respective belts the great variety of adjustment of the barriers and of the chutes formed by the barriers and the belts will be obvious. The fact that the bin partitions are adjustable is shown by Mr. Stebler's testimony [Transcript Record, page 137]; also that these bin partitions may be moved lengthwise in the machine, and that the bin space in defendant's machine is longer than the grader element.

On page 139 of the record we find Mr. Stebler's direct statement that the bin space in defendant's machine is forty-five inches longer than the end of the last grading element. See also testimony of Mr. Knight. [Transcript Record, pages 263-265, 266 and 267.] See Mr. Stebler's testimony, also, that in his machines the bin spaces are usually ten or twelve feet longer than the grader. [Transcript Record, page 169.] In other words, in the Stebler machines the extension of the bin spaces has usually been ten or twelve feet while in the defendant's machine the extension has been and is six feet six inches beyond the last grading opening or aperture. Also note Mr. Stebler's testimony that in instances his machines have been installed where the length of the bins was not longer than the grader, so that the object in such installations was that of the adjustability of the bins with relation to the adjustability of the guiding means only, and did not carry out the invention to its ultimate degree,—the longitudinal extension of the bins.

Mr. Knight's testimony [Transcript Record, pages

203 and 205] is directly that in the defendant's machines the adjustable bin partitions have the same relation to the adjustability of the deflectors or guides as in the Stebler patent; that the distributing belt in defendant's machines is inclined and extends longitudinally of the machine; that the distributing belts and bin space in defendant's machine are of greater longitudinal extension than the grading element.

It is to be again remarked that after hearing this testimony and the issue thereon raised by defendant, the court inspected the defendant's machines and found the truth of complainant's testimony.

This coincident or correlated adjustment in defendant's machines of the barriers and of the bin partitions is admitted by defendant's witness, John A. Milligan, the president of the defendant association. See his testimony on page 305 of the record. Mr. Milligan, page 306, says that the barriers are not used at all times, but that they are needed in case of enlarging a bin. "For instance, as our 26 size this last year ran heavily, the slats were used only in that instance, or wherever in any bin it was necessary where the bin was enlarged to place the obstruction to distribute properly in the one bin." Note particularly Mr. Milligan's answer to the question by the trial court at the bottom of page 306 of the record. Here Mr. Milligan directly admits that the object of this adjustment was to enlarge the bin from two feet or three feet to six feet or seven feet or eight feet. That the use of these barriers "will enable the fruit to fall which way you want into that one bin, instead of directly to that one point."



Note page 307 of the transcript of record that this was the understanding of Judge Trippet and borne out by his inspection of the machines.

See also the testimony of defendant's witness Brookhart. [Transcript Record, page 339.] He says that when running the fruit past the next grading opening "you would have to move your bin over to take care of that fruit; the bin boards are adjustable."

It is to be noted that these questions on pages 339 and 340 were asked of the defendant's witness by the court, and that after this testimony was given the court again inspected the defendant's machines.

On page 340 of the record the defendant's witness Brookhart admits that with defendant's machines the operator could carry the fruit along the runway as far as desired. Mr. Brookhart, however, makes another admission which is fatal to defendant's contentions. See his testimony on page 376 wherein, referring to these barrier boards of defendant's machines, he says that the bin partitions can be moved or adjusted absolutely at the will of the operator, and that that adjustment of the bin partitions was intended to be with relation to where the fruit was to be delivered from a given barrier board.

Defendant's witness Ofstad [Transcript Record, page 392] says that the object of the adjustment of the bins was to give capacity so that they could get packers at the bins and increase the output per day. He says [Transcript Record, page 406] that he never saw a machine with a deflector before Mr. Stebler's invention. Mr. Ofstad is shown to have been familiar with the "camel back" and the "Rayburn" installations.



In rebuttal Mr. Stebler was again called to the witness stand. His testimony on page 505, on redirect examination, is directly to the point that the same bin arrangement and the same interrelation of the adjustable bin partitions and the adjustable guides on the distributing belt can be secured in defendant's machines by the use of the so-called barriers or deflectors, as in the embodiment of his invention shown in the Stebler patent. After hearing this testimony fully the trial judge again visited the defendant's machines. It is true he did not see the particular machines at Porterville, but he did see machines which the parties agreed were identical therewith and had been manufactured and installed, by the actual defendant, Mr. Parker, in packing houses near Tustin, Orange county, California.

During the testimony of Mr. Brookhart, the court expressed the desire to again see the machines. "Now after I have heard all this evidence" [Transcript Record, page 445], Mr. Brookhart testified that these Orange county machines were practically identical with the Porterville machines, and counsel for defendant agreed therewith, and thereafter, after the conclusion of Mr. Stebler's rebuttal testimony, the court was adjourned and said machines visited and inspected in actual operation.

On the issue of infringement, therefore, this case is peculiarly one for the application of the rule that

the findings of the trial court "must be treated as unassailable."

Adamson v. Gilliland, 242 U. S. 350, 353;  
Central California Canneries Co. v. Dunkley  
Co., Case No. 2915, decided by this court Oct.  
1, 1917.

While the defendant in the argument of this appeal has given its praise to the old "camel back" apparatus, its witness Ofstad has demonstrated the value of the Stebler invention over that type of apparatus and shown us that it was to secure the advantages of economy of floor space that moved the defendant to appropriate the Stebler invention. Mr. Ofstad testifies [Transcript Record, page 414] that economy of packing house floor space is very much sought. He testifies that the advantage in defendant's installation was "because we wanted capacity in that house, and there were posts there limiting the equipment for wide graders, and consequently the Parker type and grader machine was narrower, and we could get the equipment in the required space." [Transcript Record, page 415.] His testimony commencing with the last question of page 417 and to the end of the cross-examination demonstrates to a certainty that the Stebler invention was a great improvement and possessed important practical advantages. He sums up his testimony with the statement that he, as a practical packing-house man, would not think of putting in one of the old "camel back" systems.

Defendant's theory on this appeal seems to be that the Stebler invention must be limited to the use of a

short grader or sizer and a very long distributing belt and series of bins, and that the guiding means must be arranged transversely or diagonally on the belt. Defendant argues that as thus construed the defendant's machines do not infringe. If wrong in either or both of these propositions there remains nothing to defendant's claim of non-infringement. It is clear that to so limit either the Stebler invention or the claims would be to ignore the true essence of the Stebler invention. A comparison of the several claims, held to be infringed, with defendant's machine will serve to demonstrate that such claims are not to be so limited.

### **Comparative Analysis of Stebler Distributing Apparatus Patent, Plaintiff's Exhibit 2.**

#### **STEBLER PATENT.**

#### **DEFENDANT'S MACHINES.**

##### **CLAIM I.**

(1) A fruit grading element constructed to deliver fruit at different longitudinal portions.

This is the grader and the claim does not embrace or require any adjustment of the grade-openings.

(2) *Inclined* traveling supporting and distributing "means," the inclined belt 10 and devices hav-

The grader composed of the roller sections and grading belt, whether any adjustment be possible of the grade-openings.

The inclined distributing belts arranged below the grader and the "barriers" having the function

ing the function of controlling the point of delivery as desired.

This claim specifies that the distributing apparatus shall be longer than the “grading element.” It does not say 50% longer or any specified ratio. The advantage of extension is greater bin space. This feature is not used to the same degree or extent in defendant’s machines as Mr. Stebler actually uses it, but is present to the extent of substantially 78 inches of extension beyond the last grade-opening. Would eight inches of extension beyond *the frame* of the grader infringe and defendant’s extension not infringe? We must look at what the devices do and how they do it. *Bates v. Coe*, 98 U. S.

Things are large and small only relatively. So they are extended only relatively. The purpose of extension is the same in defendant’s machine though relatively the extension is not so great.

#### CLAIM 2.

(1) A grading element (again note that adjustment of the grade-openings is not material).	The grading or separating mechanism regardless of adjustment.
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(2) The distributing belt 10.	The distributing belts.
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(3) “Guiding means” arranged along the belt,—the parts 12 or 12 and 13. Not limited to these parts connected to bars or studs	The barriers which may be adjusted on the belts in any relative desired position for conveyance and discharge.
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14 or to an inclined or transverse arrangement.

(4) Bins arranged along the length of the belt 10 and at the sides thereof.

The bins arranged along the length of the distributing or conveying belts and at the side thereof.

CLAIM 3.

(1) A grading element.

Exactly correspondence, i. e., a grading element.

(2) A traveling conveyor (10) extending longitudinally *under* said grading element.

The belts are arranged under the grading element and travel longitudinally thereof.

(3) Bins whose longitudinal extension is greater than the extension of the "grading element."

Bins whose longitudinal extension is 78 inches longer than the "grading element."

(4) Guiding means having the function "to guide the fruit" to the bins.

Guiding means, i. e., the 15, 20 or 24 inch long "barriers" having the function of guiding the fruit to the bins.

CLAIM 5.

(1) A grading element. (Adjustability of grade-openings not a factor of the claim.)

The grading element composed of the roller sections and the inclined traveling grading belt.

(2) A distributing belt. (The belt 10.)

The belts arranged at the side of the grading element and below the same.



(3) Bins made up of front and back walls, adjustable partitions, and bottoms.

(See Note.)

(4) Guiding means — (in the specification referred to in the *preferred form* of embodiment of the invention, as the parts 12, 13, which are suitably supported on suitable bars or studs 14.)

The claim calls for the capability of adjusting the outer ends, i. e., the delivery ends of the guiding means so that the portion of the bin space to which the fruit will be delivered is within the option of the operator. As it is the point of termination of the barrier formed by the part 12 or 13 that ends the resistance to the tendency of gravity to carry the fruit off the belt 10, and into the bin space, the termination of the outer end is the determining feature of delivery.

The bins made up of front and back walls, bottoms and partitions adjustable at will.

(See Note.)

The 15 inch or 20 and 24 inch long "guiding means" or "barrier" pieces which may be fixed at the will of the operator in the desired positions to deliver the fruit from a given grade-opening to a desired part of the bin space. This bin space, by means of the adjustable partitions, may be arranged at the points selected by the operator and bins may be wide or narrow and may be extended beyond the line of the opening of the next grade-opening for same adjustment of bin space and delivery as in the Stebler. The termination of the ends of these barriers is depended on the same as in the Stebler to determine the point of delivery.

This claim calls for the bin space being extended longer than the grader. It is to be particularly noted it is not limited to such extension being  $\frac{1}{4}$ ,  $\frac{1}{2}$ ,  $\frac{3}{4}$  or any relatively greater length. Any extension will to that degree utilize this feature to the extent of such extension. The extent is to degree, not differing in principle.

In defendant's machine the guiding means may be slided longitudinally of the apparatus to adjust the longitudinal or lengthwise position of the outer or discharge end of the barriers as desired, and two or more barrier pieces may be arranged in line. The purpose and function of this adjustment is the same. Full equivalency is therefore present.

CLAIM 6.

- |   |   |
|---|---|
| (1) A grading element.  | A grading element.  |
| (2) A horizontal traveling conveyor inclined downwardly away from the grading element.          | Not simply one, but more than one traveling conveyor, each of which is inclined downwardly away from the grading element.                           |
| (3) Bins arranged below and along said conveyor.  | Bins arranged below and along said conveyor.  |
| (4) Guiding means arranged along the conveyor providing chutes for directing fruit to the bins. | Guiding means consisting of what we have called for the want of a better name, "barriers," which in connection with the surface of the distributing |

belt form a chute and direct the fruit to the portion of the bin desired.

CLAIM 8.

(1) A fruit grader of the graduated rotary member and traveling belt type.

Note that the rotary member and the belt form a grading way or *chute*.

(2) A traveling conveyor arranged under the grader (the belt 10).

(3) A series of bins along the conveyor.

(4) An adjustable guiding means arranged along the conveyor and forming a chute, said guiding means being adjustable to shift the point of discharge longitudinally or lengthwise of the conveyor.

The full equivalent; the grading way or chute being composed of a rotary member and an endless belt. Either the rotary member may be adjusted toward the belt or the belt toward the rotary member.

Not only one, but several distributing belts or conveyors all arranged under the grader.

A series of bins along the conveyor.

An adjustable guiding means composed of the 15 inch or twenty inch or twenty-four inch pieces of wood or barriers when placed in position on the conveyor form in conjunction therewith a chute "for directing the graded fruit into said bins" and these pieces of wood or guiding means are adjust-

able to shift the point of discharge longitudinally of the conveyor in two ways, —each barrier may be slid in the slot along the length of the distributing system, thereby adjusting the point of discharge, or an additional barrier piece may be inserted to thus adjust the discharge, thus fully corresponding in either respect with the requirements of this claim.

CLAIM II.

(1) A fruit grading element.

A fruit grading element.

(2) A series of bins provided with adjustable partitions.

A series of bins provided with the adjustable partitions.

(3) The conveyor belt (10) traveling longitudinally between the grading element and bins.

The distributing belt or belts traveling longitudinally between the grading element and bins.

(4) Guiding means arranged along the conveyor and forming chutes, said guiding means being adjustable to shift the longitudinal position of their

Guide means which we have termed "barriers" and which may be arranged along the conveyor to form a chute or chutes for guiding the fruit to

outer or delivery ends in accordance with the longitudinal position of the walls or adjustable partitions of the bins.

the bins and which are adjustable either by sliding the barrier piece to the desired position, or by such sliding such barrier piece as desired and also putting in place an additional barrier piece or pieces so that the outer end of the chute formed by such barrier piece or pieces and the surface of the belt is adjusted to deliver the fruit in accordance with the longitudinal position or adjustment of the walls of the bin.

It is thus seen that there is an exact correspondence between the combination of claim 11 and the elements, the interrelation of the elements and the functions of the elements in the defendant's machine. Full mechanical equivalency not only of the combination as a whole but of each element exists.

CLAIM 14.

(1) A grader element of the graduated rotary member and endless belt type forming a grading way or chute.

The rotary wall member and the grading belt form a grading way or chute which for this claim is the entire, complete and



Note that adjustability of the grading openings is not an element of the claim. full mechanical equivalent.

(2) A series of bins.

A series of bins.

(3) The distributing belt (10).

The distributing belt or belts.

(4) Guiding means arranged along the conveyor forming chutes to guide the fruit to said bins.

The guiding means made up of the barrier pieces as desired, which form chutes in the same sense and for the same purpose.

#### CLAIM 15.

(1) A grader element of the graduated rotary member and endless belt type forming a grading way or chute.

A roller section and grading belt, forming the grading element are the full equivalent.

This claim does not call for any relative adjustment of the grading opening.

(2) A downwardly inclined belt extended longer than the grader.

The belt or belts of the distributing apparatus which are extended about 78 inches longer than the grading element and for the same purpose, that is, the flexibility or adjustability of the respective bin spaces.

(3) Suitable means on the belt for guiding the fruit to the bins, this suitable means being included in the term "traveling, separating and distributing means." This phrase includes the relative adjustability of the guiding means.

The adjustable and regulable at will guiding means formed by the barriers.

(4) A series of bins.

A series of bins.

CLAIM 19.

(1) A grading element.

A grading element.

(2) An inclined distributing belt 10.

Not only one but several inclined distributing belts.

(3) Guiding means arranged along the belt 10 and forming chutes for *directing* the fruit.

Guiding means arranged along the distributing belt and belts and forming chutes in the same sense.

(4) Bins arranged below and along the belt 10.

Bins arranged below and along the distributing belts.

(5) The bins having movable partitions whereby the width of the bins may be adjusted.

Same.

As said by the Circuit Court of Appeals for the Eighth Circuit in *J. L. Owens Co. v. Twin City Separator Co.*, 168 Fed. 259:

“Changes of the form, composition, or construction of parts of a device, or of some of the elements of a combination, will not avoid infringement, where the principle or mode of operation of the patentee is taken, and the changed form, composition or construction is neither a distinguishing characteristic of the invention nor material to the device or combination, or its operation.

“If two devices do the same work in substantially the same way, and accomplish the same result, they are the same, even though they differ in name, form or shape. (*Machine Co. v. Murphy*, 97 U. S. 125.)”

It follows, therefore, that the defendant’s “barriers,” although differing in form and in the name given to them, perform exactly the same function when in use and in substantially if not exactly identically the same manner as the telescopic guide means of the Stebler patent. They are therefore the same thing and full mechanical equivalents in the combination. As said further by this court in this last referred to opinion:

“But the description in a specification or drawing, of a form, or a composition, or construction, of a mechanical element, when that form, composition, or construction is not, and is not claimed to be, essential to the combination or improvement claimed, is the mere pointing out of the best mode in which the patentee contemplated applying the principle of his invention under section 4888 Rev. St. (U. S. Comp. St. 1901, page 3383), and does not deprive him of protection for mechanical equivalents or indicate that he intended to give up all other modes of application. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210

U. S. 405; National Hollow Brake Beam Co. v. Interchangeable B. B. Co., 106 Fed. 693; City of Boston v. Allen, 91 Fed. 248, 249.”

See also the opinion of this court in Los Angeles Art Organ Co. v. Aeolian Co., 143 Fed. 887, where the court says:

“The substantial identity, therefore, that is to be looked to, in cases of this kind, respects that which constitutes the essence of the invention, viz., the application of the principle. If the mode of carrying the same principle into effect adopted by the defendant, still shows only that the principle admits of the same application, in a variety of forms, or by a variety of apparatus, the jury will be authorized to treat such mode as a piracy of the original invention.”

It is clear that the defendant did not apply to the prior art for the combination which it has in its apparatus, but that on the contrary it has simulated the Stebler invention and has simply attempted to somewhat change the looks of its dress without changing the dress.

The case is a clear one of infringement, and the Stebler invention is shown to be a very meritorious invention which has taken a high place in the commercial world and should be given practical protection by the court to sustain the wholesome theory of the patent law.

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